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Filing date: **01/08/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|--|
| Proceeding | 92054201 |
| Party | Defendant Sleep Innovations, Inc. |
| Correspondence Address | ROBERT W SMITH MCCARTER ENGLISH LLP FOUR GATEWAY CENTER, 100 MULBERRY STREET NEWARK, NJ 07102 UNITED STATES rsmith@mccarter.com, ihurtado@mccarter.com, dpopovic@mccarter.com |
| Submission | Other Motions/Papers |
| Filer's Name | Irene M. Hurtado |
| Filer's e-mail | schristie@mccarter.com, ihurtado@mccarter.com, dpopovic@mccarter.com |
| Signature | /irenemhurtado/ |
| Date | 01/08/2014 |
| Attachments | Registrant's Cross-Motion, Opposition, and Declaration with Redacted Exhibits.pdf(1346670 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,916,902
For the Mark: BODIPEDIC (& Design)
Registration Date: February 8, 2011

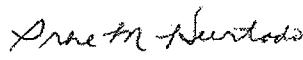
| | | |
|--------------------------|---|---------------------------|
| DAN FOAM APS |) | Cancellation No. 92054201 |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| SLEEP INNOVATIONS, INC., |) | |
| |) | |
| Registrant. |) | |

**REGISTRANT SLEEP INNOVATIONS, INC.'S CROSS-MOTION TO QUASH,
MOTION FOR A PROTECTIVE ORDER, AND TO STAY PROCEEDINGS**

Registrant, by its counsel, hereby moves before the Board: (1) to Quash the Notice of Deposition of Jane Martin for failure to disclose Ms. Martin in Petitioner's Pretrial Disclosures, (2) for a Protective Order Pursuant to Rules 26(c)(1)(B) and 32(a)(5)(A) of the Federal of Civil Procedure , and (3) to Stay Proceedings Pending a Decision on Petitioner's Motion to Amend Pretrial Disclosures and Take Deposition Telephonically and on this Cross-Motion. In support of its Cross-Motion, the Registrant relies on the accompanying Brief and the Declaration of Irene M. Hurtado.

Dated: January 8, 2014

McCARTER & ENGLISH, LLP

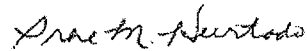
By: 
Scott S. Christie
Irene M. Hurtado

Four Gateway Center
100 Mulberry Street
Newark, New Jersey 07102
(973) 622-4444
Attorney for Registrant

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Cross-Motion , supporting brief and Declaration of Irene M. Hurtado, with Exhibits, was electronically filed with the Trademark Trial and Appeal Board, and served on counsel for Petitioner by electronic mail and overnight mail on the 8th day of January, 2014, as follows:

Amy Sullivan Cahill
Stites & Harbison PLLC
400 West Market Street, Suite 1800
Louisville, KY 40202-3352



Irene M. Hurtado

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,916,902
For the Mark: BODIPEDIC (& Design)
Registration Date: February 8, 2011

| | | |
|--------------------------|---|---------------------------|
| DAN FOAM APS |) | Cancellation No. 92054201 |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| SLEEP INNOVATIONS, INC., |) | |
| |) | |
| Registrant. |) | |

DECLARATION OF IRENE M. HURTADO

IRENE M. HURTADO, of full age, declares as follows pursuant to 28 U.S.C. §1746:

1. I am an attorney of the State of New Jersey and am an associate at the Firm of McCarter & English, LLP. This Declaration is submitted in opposition to Petitioner Dan Foam APS's ("Petitioner") Motion for Leave to Supplement Pretrial Disclosures and Motion to Conduct Deposition Telephonically (the "Motion"), and in support of Registrant's Cross-Motion to Quash the Notice of Deposition of Jane Martin for failure to disclose Ms. Martin in Petitioner's Pretrial Disclosures and to Suspend Proceedings Pending Disposition of the Motion and Cross-Motion (the "Cross-Motion").

2. Attached hereto as Exhibit 1 is a true and correct copy of Petitioner's Initial Disclosures in this proceeding, dated October 13, 2011, which do not identify Jane Martin. Petitioner has not served supplemental or amended Initial Disclosures upon Registrant at any time in this proceeding.

3. Attached hereto as Exhibit 2 is a true and correct copy of a subpoena directed to Overstock.com, Inc., and issued by counsel for petitioner in this proceeding on February 2, 2012 (the "Subpoena"). Petitioner failed to provide Registrant with notice of this Subpoena.

4. On February 10, 2012, Overstock.com produced a single document in response to the subpoena, which is a compilation of communications between Overstock.com employees or Overstock's third party customer service representatives and purported consumers (the "Compilation").

5. The discovery period in this proceeding closed on June 10, 2012. Petitioner did not seek to depose Overstock.com or Jane Martin during the discovery period.

6. On August 7, 2012, Petitioner filed a Motion for Summary Judgment, relying upon the Compilation as evidence of consumer confusion. A true and correct excerpt of Petitioner's Motion for Summary Judgment is attached hereto as Exhibit 3, and a true and correct copy of an excerpt from Exhibit S submitted in support of Petitioner's Motion for Summary Judgment is attached hereto as Exhibit 4. Exhibit 4 hereto includes excerpts of the Compilation. Because the Compilation contains personal data, it has been designated as "Confidential" pursuant to the Stipulated Protective Order entered in this proceeding. As such, Exhibit 4 is filed under seal.

7. Attached hereto as Exhibit 5 is a true and correct copy of Petitioner's Pretrial Disclosures in this proceeding, dated November 1, 2013, which do not identify Jane Martin as a potential witness. Petitioner has not served supplemental or amended Pretrial Disclosures upon Registrant at any time in this proceeding.

8. Petitioner's testimony period was scheduled to close on December 17, 2013. On December 16, 2013, the parties entered into and Petitioner filed with the Board a Joint Motion

for Approval of Stipulation, which extended Petitioner's testimony period until January 17, 2013. The Board has not yet ruled on the Joint Motion.

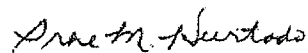
9. Attached hereto as Exhibit 6 is a true and correct copy of the transcript of the deposition of Mohican Laine, a representative of Overstock.com, taken in this proceeding on December 17, 2013.

10. Petitioner notified Registrant for the first time on January 3, 2014 at 5:04 p.m. of its intent to depose Ms. Martin on January 10, 2014, in an email attaching copies of Petitioner's Motion and the Notice of Deposition directed to Ms. Martin.

11. Registrant has never received a copy of any subpoena directed to Ms. Martin and, to Registrant's knowledge, Petitioner has not issued a subpoena to Ms. Martin.

I hereby declare that the foregoing statements made by me are true. I am aware that if any of the foregoing statements made by me are willfully false, I am subject to punishment.

Executed this 8th day of January, 2014, in Newark, New Jersey.



Irene M. Hurtado

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DAN FOAM APS,

Petitioner,

v.

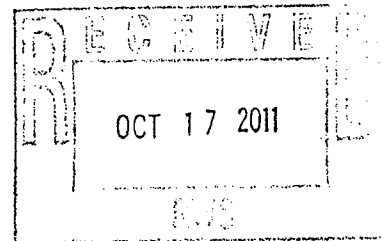
SLEEP INNOVATIONS, INC.,

Registrant.

Cancellation Proceeding 92/054,201

**PETITIONER'S INITIAL DISCLOSURES
PURSUANT TO FED. R. CIV. P. 26(a)(1)**

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and 37 C.F.R. § 2.120, Petitioner, Dan Foam APS ("Petitioner"), hereby serves its Initial Disclosures in the above-captioned proceeding. Petitioner's investigation is ongoing and these disclosures are based upon the information reasonably available to Petitioner at this time. Petitioner reserves the right to remove from these disclosures any individual or document, if Petitioner learns that the information known by such individual or contained in such document is not discoverable, and while Petitioner assumes no obligation to voluntarily supplement or amend these disclosures to reflect information and/or documents discovered following the service of these disclosures, Petitioner also reserves the right to modify or supplement the information provided in these disclosures based upon continuing investigation and discovery in this proceeding. Petitioner reserves any applicable privileges that may apply to this disclosure and further supplemental disclosures, if any, or other potential discovery, including attorney-client and work product privileges.



I. IDENTIFICATION OF INDIVIDUALS PURSUANT TO FED. R. CIV. P. 26(A)(1)(A)(I)

Petitioner identifies the person listed below as the individual who may have discoverable information that Petitioner may use to support its claims and defenses. Petitioner has provided contact information solely to comply with Rule 26(a)(1)(A), and does not consent to or authorize any communications with any of its current or former employees or any communications which are otherwise prohibited by applicable rules of professional conduct.

1. Dan Setlak, Vice-President of Marketing
Tempur-Pedic International, Inc.

Subjects – History and background of Petitioner and Petitioner's ownership of its TEMPUR-PEDIC and TEMPUR-PEDIC (& Design) marks ("Petitioner's Marks"); the history, and background of Petitioner's products and related intellectual property rights; the subject matter of the categories of documents identified as within the custody or control of Petitioner listed below; Petitioner's use of Petitioner's Marks in the United States; the strength of Petitioner's Marks in the United States in the relevant industry; the nature of Petitioner's goods sold in connection with Petitioner's Marks; Petitioner's sales, advertising, marketing, and distribution of goods under Petitioner's Marks in the United States; the renown and consumer recognition of Petitioner's Marks in the United States; patents relating to products sold under Petitioner's Marks; channels of trade and intended consumers for goods bearing Petitioner's Marks; written agreements relating to Petitioner's Marks.

2. Knowledgeable Representative(s)
Sleep Innovations, Inc.

Subjects – The origin and development of Registrant's BODIPEDIC (& Design) mark including any original artwork developed therefor ("Registrant's Mark"); Registrant's adoption

and registration of Registrant's Mark; searches, investigations, and opinions obtained in relation to adoption and registration of Registrant's Mark; nature, purpose, and quality of the products sold under Registrant's Mark; Registrant's consideration of alternatives to Registrant's Mark; Registrant's channels of trade and purchasers for the products sold under Registrant's Mark; Registrant's knowledge of Petitioner and of Petitioner's Marks; agreements relating to Registrant's Mark or the products to be sold under Registrant's Mark; Registrant's intent to trade on the goodwill of Petitioner's Marks; the subject matter of the categories of documents identified as within the custody or control of Registrant listed below.

II. DESCRIPTION OF DOCUMENTS PURSUANT TO FED. R. CIV. P. 26(A)(1)(A)(II)

A. Petitioner identifies the following categories of documents in its possession, custody, or control that it may use to support its claims. The documents identified are located at the offices of Petitioner, 1713 Jaggie Fox Way, Lexington, Kentucky 40511, or may be retrieved by Petitioner from remote locations, or are available at the offices of Petitioner's counsel.

1. Certified status and title copies of U.S. registrations of Petitioner's Marks to be obtained from the U.S. Patent and Trademark Office.
2. Documents relating to the history and background of Petitioner.
3. Documents relating to the chain of title in ownership of Petitioner's Marks.
4. Documents relating to and demonstrating the bona fide use in commerce of Petitioner's Marks in connection with goods sold in the United States.
5. Documents relating to the nature and quality of Petitioner's goods.
6. Documents relating to Petitioner's sales, advertising, marketing, and distribution of products under Petitioner's Marks in the United States.

7. Documents relating to the strength, renown, and consumer recognition of Petitioner's Marks in the United States including the goodwill enjoyed by Petitioner in the marks, including through use by related companies.

8. Documents related to the channels of trade for goods to be sold in commerce under Registrant's Mark.

9. Documents relating to the classes of purchasers for goods sold under Registrant's Mark.

10. Documents relating to the likelihood of confusion with Petitioner's Mark that is or may be caused by the use and registration of Petitioner's Mark.

B. Petitioner identifies the following categories of documents believed to be in Registrant's possession, custody, or control that Petitioner may use to support its claims and defenses in this matter.

1. Documents relating to Registrant's creation and adoption of Registrant's Mark, including its design element.

2. Documents relating to Registrant's registration of Registrant's Mark.

3. Documents relating to market research (including, surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Registrant in connection with Registrant's Mark.

4. Documents relating to the nature and quality of products sold under Registrant's Mark.

5. Documents relating to Registrant's knowledge of Petitioner, Registrant's knowledge of Petitioner's Marks, and Registrant's knowledge of products sold bearing Petitioner's Marks in commerce.

6. Documents relating to searches, investigations, and/or legal opinions prepared by Registrant or on Registrant's behalf relating to its adoption of Registrant's Mark, its decision to register Registrant's Mark.

7. Documents relating to actual confusion between the source of goods bearing Petitioner's Marks and the source of goods bearing Registrant's Marks.

8. Documents relating to Registrant's sale of goods under Registrant's Mark in commerce.

9. Documents related to the channels of trade for goods to be sold in commerce under Registrant's Mark.

10. Documents relating to the classes of purchasers for goods sold under Registrant's Mark.

11. Documents containing descriptions of the types of products sold under Registrant's Mark and the nature, function, and purpose of each such product.

12. Packaging for goods sold by Registrant bearing Registrant's Mark.

13. Documents relating to Registrant's consideration of alternatives to Registrant's Mark.

14. Documents reflecting Registrant's intent to trade on the goodwill of Petitioner or Petitioner's Marks.

15. Samples of any or all products which Registrant sells under Petitioner's Mark.

16. Documents relating to the ownership and licensing of Registrant's Mark.

17. Documents bearing on the likelihood confusion that would be caused by Petitioner's continued use and registration of Petitioner's Marks.

III. DAMAGES

Not applicable.

IV. INSURANCE

Not applicable.

Petitioner reserves the right to supplement its Initial Disclosures.

Respectfully submitted,

By: s/Amy Sullivan Cahill/
Amy Sullivan Cahill
STITES & HARBISON PLLC
400 West Market Street
Suite 1800
Louisville, Kentucky 40202
Tel: 502-587-3400
Fax: 502-587-6391
Email: acahill@stites.com

Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on October 13, 2011 a copy of the Petitioner's Initial Disclosures were served on counsel for Registrant, via first class mail, postage prepaid to:

ROBERT W SMITH
MCCARTER & ENGLISH LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK, NJ 07102
mboyce@mccarter.com

s/Amy Sullivan Cahill

DI65:41805:853522:1:LOUISVILLE

EXHIBIT 2

UNITED STATES DISTRICT COURT

for the
District of Utah

| | | |
|-------------------------|---|---|
| Dan Foam APS |) | |
| Plaintiff |) | |
| v. |) | Civil Action No. Cancellation No. 92054201 |
| Sleep Innovations, Inc. |) | |
| Defendant |) | (If the action is pending in another district, state where: Trademark Trial and Appeal Board) |

SUBPOENA TO PRODUCE DOCUMENTS, INFORMATION, OR OBJECTS
OR TO PERMIT INSPECTION OF PREMISES IN A CIVIL ACTION

To: Overstock.com, Inc., ATTN: Krysta Pecharich, 6350 South 3000 East, Salt Lake City, Utah 84121

☒ **Production:** YOU ARE COMMANDED to produce at the time, date, and place set forth below the following documents, electronically stored information, or objects, and permit their inspection, copying, testing, or sampling of the material: All customer inquiries regarding any Bodipedic product including the term "TEMPUR," "TEMPER," "TEMPUR-PEDIC," or "TEMPURPEDIC"

| | |
|--|---------------------------------------|
| Place: Stites & Harblson, PLLC, ATTN: Amy Cahill 400 W. Market St., Ste. 1800 Louisville, KY 40202 | Date and Time: 02/23/2012 12:00 pm |
|--|---------------------------------------|

☐ **Inspection of Premises:** YOU ARE COMMANDED to permit entry onto the designated premises, land, or other property possessed or controlled by you at the time, date, and location set forth below, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.

| | |
|--------|----------------|
| Place: | Date and Time: |
|--------|----------------|

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Rule 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: 02/02/2012

CLERK OF COURT

OR

Signature of Clerk or Deputy Clerk

Attorney's signature

The name, address, e-mail, and telephone number of the attorney representing (name of party) Dan Foam APS, who issues or requests this subpoena, are:
Amy S. Cahill, Stites & Harblson PLLC, 400 W. Market St., Ste. 1800, Louisville, Kentucky 40202; acahill@stites.com; (502) 681-0597

EXHIBIT 3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*******CONFIDENTIAL DOCUMENT – FILED UNDER SEAL*******

| | | |
|--------------------------|---|---------------------------|
| DAN FOAM APS |) | |
| |) | |
| Petitioner, |) | |
| |) | Cancellation No. 92054201 |
| v. |) | |
| |) | |
| SLEEP INNOVATIONS, INC., |) | |
| |) | |
| Registrant. |) | |

PETITIONER’S MOTION FOR SUMMARY JUDGMENT

Petitioner Dan Foam APS, by counsel, submits this motion for summary judgment pursuant to TBMP § 528 and Fed. R. Civ. P. 56. Discovery has been completed and no material factual issues remain in dispute. Accordingly, this proceeding is appropriately decided on the evidence of record as a matter of law.

I. BACKGROUND AND STANDING

Petitioner filed a Petition for Cancellation seeking to cancel the registration for Respondent’s BODIPEDIC & Reclining Figure Mark, Registration No. 3,916,902, issued on February 8, 2011, for use in connection with mattresses, pillows, and mattress toppers in International Class 20. Petitioner relies on a priority of rights and a likelihood of confusion between the BODIPEDIC & Reclining Figure Mark and Petitioner’s TEMPUR-PEDIC & Reclining Figure Mark under 15 U.S.C. § 1125(d), and brings its petition within five years of the date of the challenged registration pursuant to TBMP § 307.02(a).

Petitioner as owner of the TEMPUR-PEDIC & Reclining Figure Mark has standing to challenge the registration as it has a real interest in the proceeding and a reasonable basis for its

from Overstock.com documented these exchanges with customers.³⁶ The following exchange is representative of these documented communications:

Visitor: Well, even though all you're selling is excess from the original company, why is everything as cheap as it is? I mean, are you selling the bad excess? I was looking at a tempurpedic mattress and it was \$1,000 off. There's obviously something wrong with it.

Darien: To help you better, may I know the catalog number of the mattress you're referring to?

Visitor: I'm still interested in buying it, I just want to know what the catch is to all this.

Darien: That's great.

Visitor: Catalog #: 1015449³⁷

Darien: Let me check that for you. Darien: Thank you for the catalog number.

Darien: Are you referring to the '8-inch Memory Foam Mattress'.

Darien: *?

Visitor: Yes, I am

Darien: Thank you for confirming the item. Darien: I have checked and I see that it a new product and it's a good quality mattress.³⁸

On multiple occasions, consumers refer to the BODIPEDIC products already purchased from Overstock.com as "TEMPUR-PEDIC" brand products.

Visitor 1: I just ordered a Queen Size tempurpedic and mattress cover and my email address is [omitted]... the address I would like to have it mailed to is [omitted].³⁹

...

³⁶ Documents produced by Overstock.com pursuant to subpoena along with a Declaration from Overstock.com attesting that the documents are genuine and authentic copies of business records kept in the normal course of business are attached as Exhibit S. TBMP § 528.05(b) and Fed.R.Civ.P. 56(c)(4).

³⁷ 1015449 is a "catalog" number associated with the BODIPEDIC & Reclining Figure Design 10 inch mattress. Exhibit T.

³⁸ Overstock.com Documents, p. 17, Incident ID 46341 attached as Exhibit S.

³⁹ Overstock.com Documents, pp. 51-52, Incident ID 4974119 attached as Exhibit S.

Visitor 2: Yes, thank you, I purchased a queen size tempurpedic mattress which I am very pleased with, however I noted that when I but [sic] my new bed together along with the new mattress, there was a statement on the bottom of the mattress that the product was not supposed to be used without a box spring. Do you carry them? ...Did you offer the tempurpedic mattress as a set?⁴⁰

On at least one occasion, a consumer assumed that the BODIPEDIC & Reclining Figure Design pillows were in fact a line of mattresses manufactured by Petitioner in making a purchase. Following the purchase, the consumer contacted the company to determine whether Sleep Innovations was the manufacturer of the TEMPUR-PEDIC brand pillows he had received.

Visitor: i have an issue with pillows

Fletcher: Are you referring to the 'Memory Foam Standard Size Contour Pillow', qty 2?

Visitor: yes

Fletcher: Would you mind holding for 3-5 minutes while I check that for you?

Visitor: sure

Fletcher: Thanks for holding.

Fletcher: I see that you have received the right pillows. It is just manufactured by Sleep Innovations.

Visitor: yes, but on the picture it says BodiPedic, not Sleeping Innovations

Fletcher: Let me check. Fletcher: Please give me a minute or two.

Visitor: ok

Fletcher: Thanks for holding. I am sorry for the delay. I see that the Bodipedic is brand name and it is manufactured by Sleep Innovations.

Visitor: what about tempur pedic is it made by sleep innovations?

Fletcher: Do you have catalog number of the item?

⁴⁰ Overstock.com Documents, pp. 52-53, Incident ID 5035089 attached as Exhibit S.

EXHIBIT 4

**CONFIDENTIAL AND HIGHLY
CONFIDENTIAL – ATTORNEYS' EYES
ONLY INFORMATION**

FILED UNDER SEAL

REDACTED

EXHIBIT 5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|--------------------------|---|------------------------------------|
| DAN FOAM APS, |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | Cancellation Proceeding 92/054,201 |
| |) | |
| SLEEP INNOVATIONS, INC., |) | |
| |) | |
| Registrant. |) | |

PETITIONER'S PRETRIAL DISCLOSURES
PURSUANT TO FED. R. CIV. P. 26(a)(3) AND 37 C.F.R. § 2.121(e)

Pursuant to Federal Rule of Civil Procedure 26(a)(3) and 37 C.F.R § 2.121(e), Petitioner, Dan Foam APS ("Petitioner"), hereby serves its Pretrial Disclosures in the above-captioned proceeding.

Petitioner's investigation is ongoing and these disclosures are based upon the information reasonably available to Petitioner at this time. Petitioner reserves the right to remove from these disclosures any individual or document, if Petitioner learns that the information known by such individual or contained in such document is not discoverable, and while Petitioner assumes no obligation to voluntarily supplement or amend these disclosures to reflect information and/or documents discovered following the service of these disclosures, Petitioner also reserves the right to modify or supplement the information provided in these disclosures based upon continuing investigation and discovery in this proceeding. Petitioner reserves any applicable privileges that may apply to this disclosure and further supplemental disclosures, if any, or other potential discovery, including attorney-client and work product privileges.

DEFINITIONS

The phrase "Petitioner's Marks" shall mean those marks on which Petitioner relies in its Petition for Cancellation filed in this matter.

The phrase "Petitioner's Goods" shall mean those goods sold in connection with Petitioner's Marks.

The phrases "Registrant's Mark" and "Registrant's BODIPEDIC (& Design)" mark shall mean the mark that is the subject Registration No. 3,916,902.

The phrase "Registrant's Goods" shall mean those goods sold in connection with Registrant's Mark.

DISCLOSURES

I. IDENTIFICATION OF INDIVIDUALS PURSUANT TO FED. R. CIV. P. 26(A)(3)

Petitioner provides the name and contact information of each witness from whom it expects to take and/or rely on testimony during the trial period of this matter and those from whom Petitioner may take and/or rely on testimony if the need arises. Per Rule 26(a)(3), Fed. R. Civ. P., this list does not include those witnesses whom Petitioner may seek testimony from solely for purposes of impeachment. Petitioner has provided contact information solely to comply with Rule 26(a)(3), and does not consent to or authorize any communications with any of its current or former employees or any communications which are otherwise prohibited by applicable rules of professional conduct.

1. Dan Setlak, Vice-President of Marketing
Tempur-Pedic North America, LLC
May be contacted through Petitioner's Counsel

Subjects – Petitioner's ownership of its TEMPUR-PEDIC and TEMPUR-PEDIC (& Design) marks ("Petitioner's Marks"); the history and background of Petitioner's Goods and

related intellectual property rights; the subject matter of the categories of documents identified as within the custody or control of Petitioner listed below; Petitioner's use of Petitioner's Marks in the United States; the strength of Petitioner's Marks in the United States; the nature of Petitioner's Goods sold in connection with Petitioner's Marks; Petitioner's sales, advertising, marketing, and distribution of goods under Petitioner's Marks in the United States; the renown and fame of Petitioner's Marks in the United States; patents relating to products sold under Petitioner's Marks; channels of trade and intended consumers for goods bearing Petitioner's Marks; written agreements relating to Petitioner's Marks; Petitioner's exercise of quality control in connection with goods sold bearing Petitioner's Marks; the similarities between Registrant's Mark and Petitioner's Marks; the likelihood of confusion between Registrant's Mark and Petitioner's Marks.

2. Dave Hochwalt, Vice-President, Global Tax
Tempur-Pedic North America, LLC
May be contacted through Petitioner's counsel

Subjects – Corporate structure and history of Petitioner, Petitioner's predecessors in interest, successors in interest, and its related companies; Petitioner's ownership of Petitioner's Marks; use of Petitioner's Marks by Petitioner's related companies in the U.S.; the manufacture and distribution of goods bearing Petitioner's Marks in the U.S.; the history of business goodwill associated with Petitioner's Marks in connection with corporate acquisitions, mergers, and change(s) of names; Petitioner's quality control over products sold bearing Petitioner's Marks.

3. Sarah Hajjar, Director, Interactive Marketing or
Patrice Varni, Vice-President, Direct to Consumer
Tempur-Pedic North America, LLC
May be contacted through Petitioner's counsel

Subjects – The promotion and sale of goods bearing Petitioner's Marks on the Internet.

4. Joe Zucconi

Zuconni Idea Agency
3131 Route 38, Second Floor, Suite 11B
Mount Laurel, NJ 08054
Tel. 856-222-9939

Subjects – Registrant's knowledge of Petitioner and Petitioner's Marks; the development of Registrant's branding materials and advertising incorporating the challenged BODIPEDIC (& Design) mark. Documents produced by Zuconni Idea Agency in connection with this proceeding.

5. Lisa Thorstenson
Employee of Registrant

The creation, selection, and development of Registrant's BODIPEDIC (& Design) mark; Registrant's knowledge of Petitioner and Petitioner's TEMPUR-PEDIC (& Reclining Figure Design) mark; Registrant's market research relevant to the selection of the BODIPEDIC (& Design) mark and market research relevant to sales of BODIPEDIC (& Design) Products; the date of first use of Registrant's BODIPEDIC (& Design) mark in connection with the sale of Registrant's Goods; the manner in which Registrant's BODIPEDIC (& Design) mark has been used in connection with each of Registrant's Goods; the marketing and advertising efforts (including trade show attendance) made and planned to promote Registrant's BODIPEDIC (& Design) Products; the channels of trade through which Registrant sells and the customers to whom Registrant sells its BODIPEDIC (& Design) Products; the authenticity of all documents produced by Registrant in discovery to date; Registrant's current business operations or future business plans that include the use or planned use of BODIPEDIC (& Design); license agreements in place for Registrant's BODIPEDIC (& Design) mark; actual confusion or potential confusion between the BODIPEDIC (& Design) mark and the TEMPUR-PEDIC (& Reclining Figure Design) mark; surveys or experts retained to prove the legal claims asserted by

Registrant in this proceeding; sales information relating to Registrant's BODIPEDIC (& Design) Products; customers of Registrant's BODIPEDIC (& Design) Products; sales channels for Registrant's BODIPEDIC (& Design) Products; similarities between Petitioner's Marks and Registrant's Mark; likelihood of confusion between Petitioner's Marks and Registrant's Mark; Registrant's Answers to Petitioner's First Set of Interrogatories, Registrant's Responses to Petitioner's First and Second Requests for Admissions.

6. Sharon Miller
Employee of Registrant

Subjects – Registrant's knowledge of Petitioner and Petitioner's Marks; communication between Miller and outside advertising agencies; development of brand architecture and packaging materials incorporating the challenged BODIPEDIC (& Design) mark; similarities between Petitioner's Marks and Respondent's Mark; likelihood of confusion between Petitioner's Marks and Respondent's Mark.

7. Michael Loomis
Employee of Registrant

Subjects – The nature and function of the products sold in connection with Registrant's BODIPEDIC (& Design) mark; consumer facing claims associated with Registrant's BODIPEDIC (& Design) mark; product testing of Petitioner's Goods and Registrant's Goods; product packaging for Petitioner's Goods and Registrant's Goods; similarities between Petitioner's Marks and Respondent's Mark; likelihood of confusion between Petitioner's Marks and Registrant's Mark.

8. Krysta Pecharich, Paralegal
Other Representative(s) of Overstock.com
www.Overstock.com
Tel. 801-947-4370

Subjects – Registrant's knowledge of Petitioner; evidence of actual confusion among consumers between Petitioner's Goods and Registrant's Goods; sales of Registrant's Goods through www.overstock.com; documents produced by Overstock.com pursuant to subpoena in connection with this proceeding; Overstock.com business practices relating to consumer product inquiries; Overstock.com record keeping procedures relating to consumer product inquiries; communications with consumers and potential consumers of Registrant's Goods sold in connection with Registrant's Mark; reliability and authenticity of documents produced by Overstock.com in this matter pursuant to subpoena; sales channels for Registrant's products sold in connection with Registrant's Mark.

9. Representative(s) of CFKI, LLC f/k/a Interscope
Represented by counsel
Jesse B. Schneider
Davis & Gilbert LLP
1740 Broadway
New York, NY 10019

Subjects – Registrant's knowledge of Petitioner; Registrant's consumers and potential consumers; documents produced by CFKI f/k/a Interscope pursuant to subpoena in connection with this proceeding; likelihood of confusion between Petitioner's Mark and Registrant's Mark.

II. DESCRIPTION OF DOCUMENTS PURSUANT TO FED. R. CIV. P. 26(A)(3)

Petitioner identifies the following categories of documents or other exhibits that it plans to introduce in the trial period for this matter.

Documents produced pursuant to subpoena by www.Overstock.com

Documents produced pursuant to subpoena by Zucconi Idea Agency

Documents produced pursuant to request by Spalding Graphic Media

Documents produced pursuant to subpoena by CFKI, LLC

Certified status and title copies of U.S. registrations of Petitioner's Marks to be obtained from the U.S. Patent and Trademark Office

Documents relating to the history and background of Petitioner

Documents relating to the chain of title in ownership of Petitioner's Marks

Documents relating to Petitioner's quality control over Petitioner's Goods bearing Petitioner's Marks

Documents evidencing unsolicited third-party media attention provided to Petitioner's Goods bearing Petitioner's Marks

Documents relating to the nature and quality of Petitioner's Goods

Documents relating to marketing and sales of Petitioner's Goods, Petitioner's web traffic and sales associated with www.TempurPedic.com

Documents relating to Petitioner's sales, advertising, marketing, and distribution of products under Petitioner's Marks in the United States

Documents relating to the strength, renown, and consumer recognition of Petitioner's Marks in the United States including the goodwill enjoyed by Petitioner in the marks, including through use by related companies

Documents related to the channels of trade for goods to be sold in commerce under Registrant's Mark

Documents relating to the creation and development of Petitioner's Mark

Documents relating to the classes of purchasers for goods sold under Registrant's Mark

Documents relating to Registrant's creation and adoption of Registrant's Mark, including its design element

Documents relating to Registrant's registration of Registrant's Mark

Documents relating to market research (including, surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Registrant in connection with Registrant's Mark

Documents relating to the nature and quality of products sold under Registrant's Mark

Documents relating to Registrant's knowledge of Petitioner, Registrant's knowledge of Petitioner's Marks, and Registrant's knowledge of products sold bearing Petitioner's Marks in commerce

Documents relating to actual confusion between the source of goods bearing Petitioner's Marks and the source of goods bearing Registrant's Marks

Documents relating to Registrant's sale of goods under Registrant's Mark in commerce

Documents related to the channels of trade for goods to be sold in commerce under Registrant's Mark

Documents relating to the classes of purchasers for goods sold under Registrant's Mark.

Documents containing descriptions of the types of products sold under Registrant's Mark and the nature, function, and purpose of each such product

Packaging for goods sold by Registrant bearing Registrant's Mark

Documents relating to Registrant's consideration of alternatives to Registrant's Mark

Documents reflecting Registrant's intent to trade on the goodwill of Petitioner or
Petitioner's Marks

Documents bearing on the likelihood confusion that would be caused by Registrant's continued use and registration of Registrant's Mark

Respectfully submitted,

By: s/Amy Sullivan Cahill/
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Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on November 1, 2013 a copy of the Petitioner's Pretrial Disclosures were served on counsel for Registrant, via first class mail, postage prepaid to:

IRENE HURTADO
ROBERT W SMITH
MCCARTER & ENGLISH LLP
FOUR GATEWAY CENTER
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s/Amy Sullivan Cahill

DI65:42033:891589:1:LOUISVILLE

EXHIBIT 6

**CONFIDENTIAL AND HIGHLY
CONFIDENTIAL – ATTORNEYS' EYES
ONLY INFORMATION**

FILED UNDER SEAL

REDACTED

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,916,902
For the Mark: BODIPEDIC (& Design)
Registration Date: February 8, 2011

| | | |
|--------------------------|---|---------------------------|
| DAN FOAM APS |) | Cancellation No. 92054201 |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| SLEEP INNOVATIONS, INC., |) | |
| |) | |
| Registrant. |) | |

**REGISTRANT'S BRIEF IN OPPOSITION TO PETITIONER'S MOTION TO AMEND
PRETRIAL DISCLOSURES AND TAKE DEPOSITION TELEPHONICALLY AND IN
SUPPORT OF CROSS-MOTION TO QUASH, MOTION FOR A PROTECTIVE
ORDER, AND TO STAY PROCEEDINGS**

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Attorney for Registrant

PRELIMINARY STATEMENT

Registrant Sleep Innovations, Inc. (“Registrant”) submits this brief in opposition to Petitioner Dan Foam APS’s (“Petitioner”) Motion for Leave to Supplement Pretrial Disclosures and Motion to Conduct Deposition Telephonically (the “Motion”), and in support of Registrant’s Cross-Motion to Quash the Notice of Deposition of Jane Martin for failure to disclose Ms. Martin in Petitioner’s Pretrial Disclosures, Motion for a Protective Order Pursuant to Rules 26(c)(1)(B) and 32(a)(5)(A) of the Federal of Civil Procedure¹, and to Stay Proceedings Pending a Decision on the Motion and Cross-Motion (the “Cross-Motion”).

Petitioner’s contention that it was “unaware of the relevance of Ms. Martin’s interactions with retailer Overstock.com and her potential to serve as a witness until December 17, 2013, after Petitioner deposed a representative of Overstock.com” is a blatant façade. Notably, Petitioner has failed to support its Motion with a declaration or other sworn statement detailing its reasons for failure to previously disclose Ms. Martin as a witness.

In February of 2012, while discovery in this matter was still open, Petitioner had possession of documents not only disclosing Ms. Martin’s identity, but a transcript of Ms. Martin’s communications with Overstock.com’s customer service representative. Declaration of Irene M. Hurtado (“Hurtado Decl.”), Ex. 4. More troubling, however, is Petitioner’s patently false assertion that it was “unaware of the relevance of Ms. Martin’s interactions with Overstock.com.” Indeed, Petitioner, in its brief in support of its Motion for Summary Judgment, quoted the very exchange between Ms. Martin and Overstock.com’s customer service representative and characterized it as an example of “consumers refer[ing] to the BODIPEDIC

¹ Registrant hereby moves for a protective order pursuant to Fed. R. Civ. P. Rules 26(c)(1)(B) and 32(a)(5)(A) (“A deposition may not be used against a party who, having received less than 14 days’ notice of the deposition, promptly moved for a protective order.”) As discussed herein and in the Declaration of Irene M. Hurtado, submitted

products already purchased from Overstock.com as ‘TEMPUR-PEDIC’ brand products.”

Hurtado Decl., Ex. 3.

Petitioner admittedly failed to identify Ms. Martin in its Initial Disclosures or in its Pretrial Disclosures, and failed to supplement either of these disclosures to identify Ms. Martin. It did so despite the fact that Petitioner plainly knew about Ms. Martin and the substance of her purported communications with Overstock.com in February of 2012 and undoubtedly understood the alleged relevance and import of those communications in the context of this proceeding when it filed its Motion for Summary Judgment on August 2, 2012 – more than a year before it served its Pretrial Disclosures. Instead, Petitioner waited until January 3, 2014 – 14 days before the close of Petitioner’s already extended testimony period, almost a full two years after Petitioner received documents placing it on notice of Ms. Martin’s identity and the purportedly relevant testimony, and 17 days after the deposition of Overstock.com – to file its Motion and to notify Registrant of its intention to depose Ms. Martin on January 10, 2014, a mere 6 days later.

Petitioner’s Motion should be denied in its entirety and Registrant’s Cross-Motion should be granted as Petitioner’s failure to disclose Ms. Martin as a witness in its Pretrial Disclosures was not “justified” and the record clearly contradicts Petitioner’s claim that it did not “discover” the “relevance of Ms. Martin’s consumer interactions with Overstock.com . . . until recently.”

If the Board permits Petitioner to amend its Pretrial Disclosures at this late date and allows Petitioner to depose Ms. Martin, Registrant respectfully requests that the discovery period be reopened for the limited purpose of allowing Registrant to take the discovery deposition of Ms. Martin and to take any additional discovery necessary as a result of Ms. Martin’s testimony and Petitioner’s belated disclosure of Ms. Martin as a witness.

herewith, Petitioner notified Registrant of its intention to depose Ms. Martin on January 10, 2014 for the first time at 5:04 p.m. on January 3, 2014. Six days’ notice prior to a deposition is insufficient notice.

FACTUAL AND PROCEDURAL BACKGROUND

On July 1, 2011, Petitioner filed a Petition seeking cancellation of Registrant's BODIPEDIC & Design mark ("Registrant's Mark"). On October 13, 2011, Petitioner served its Initial Disclosures in this proceeding. Hurtado Decl., Exhibit 1. Petitioner has not served supplemental or amended Initial Disclosures upon Registrant at any time in this proceeding. *Id.*, ¶ 2.

During the discovery period, Petitioner served a subpoena dated February 2, 2012 upon to Overstock.com, Inc. seeking production of documents (the "Subpoena"). Hurtado Decl., Exhibit 2. On February 10, 2012, Overstock.com produced a single document in response to the Subpoena, a compilation of communications between Overstock.com employees or Overstock's third party customer service representatives and purported consumers (the "Compilation"). *Id.*, ¶¶ 4 and 6, Exhibit 4. The Compilation includes a purported communication between Ms. Martin and an Overstock.com representative. *Id.*, Exhibit 4 (see entry number 5035089, pages 52-53). Petitioner did not depose Overstock.com or Ms. Martin during the discovery period in this proceeding, which closed on June 10, 2012. *Id.*, ¶ 5.

On August 7, 2012, Petitioner filed a Motion for Summary Judgment, relying upon the Compilation as evidence of consumer confusion. Hurtado Decl., Exhibits 3 and 4. In Petitioner's Motion for Summary Judgment, Petitioner included excerpts from the Compilation of exchanges between purported consumers and Overstock.com representatives, which Petitioner argued were evidence of consumer confusion. Indeed, one such excerpt included by Petitioner in its brief, characterized as evidence of "significant actual confusion," is a portion of Ms. Martin's purported communication with Overstock.com. When discussing Ms. Martin's purported communication with Overstock.com, Petitioner characterized it as an instance of "consumers

refer[ing] to the BODIPEDIC products already purchased from Overstock.com as ‘TEMPUR-PEDIC’ brand products.” *Id.*, Exhibits 3 and 4.

Despite its clear knowledge of Ms. Martin’s identity and the alleged import and relevance of her purported communication with Overstock.com, Petitioner failed to identify Ms. Martin in its Pretrial Disclosures or to timely serve supplemental Pretrial Disclosures. Hurtado Decl., Exhibit 5.

On December 17, Petitioner deposed a representative of Overstock.com concerning the Compilation. Hurtado Decl., Exhibit 6. That deposition did not yield any new or additional information concerning Ms. Martin or the relevance of her purported communication with Overstock.com. *Id.*, Exhibit 6.

Petitioner waited until after 5 p.m. on January 3, 2014 – 17 days after the deposition of Overstock.com and a mere 14 days before the close of its extended 60 day testimony period and – to file a motion seeking to amend its Pretrial Disclosures. On that same day, Petitioner notified Registrant for the first time of its intent to depose Ms. Martin on January 10, 2014, 6 days prior to the noticed deposition.

ARGUMENT

I. Petitioner Was Required to Supplement its Initial Disclosures to Identify Ms. Martin and to Identify Ms. Martin in Petitioner’s Pretrial Disclosures.

Parties to a proceeding before the Board are required to make certain disclosures, including initial disclosures and pretrial disclosures, during the course of such proceedings and are required to supplement those disclosures in a timely fashion when new information is discovered that impacts such disclosures or where a party discovers that such disclosures are incomplete or incorrect. *See* 37 C.F.R. § 120(a)(1) and (2); Trademark Trial and Appeal Board

Manual of Procedure (“TBMP”) at § 401.02, Third Edition, Revision (June 2012); 37 C.F.R. §2.121(e); TBMP at § 702.01.

A party is obligated to identify in its initial disclosures “each individual likely to have discoverable information” together with the “subjects of that information” that the party may use to support its claims or defenses.” *See* 37 C.F.R. § 2.116 and Fed. R. Civ. P. 26(a)(1)(A)(i). The Board has noted that “unless seasonably remedied, a party’s failure to identify a witness in its initial disclosures deprives the adverse party of the opportunity to seek discovery of the identified witness and this fact ‘must [be] consider[ed] . . . as one of the relevant circumstances in determining whether to strike [the witness’s] testimony deposition.’” *Spier Wines (PTY) Ltd. v. Ofer Z. Shepherd*, 105 U.S.P.Q. 2d 1239, 1242 (TTAB 2012) (granting motion to strike pretrial disclosure and quash opposer’s notice of deposition of witness based upon opposer’s failure to identify witness in its initial disclosures or at any time during discovery period).

Pretrial disclosures, identifying all witnesses from whom a party intends to illicit testimony during its testimony period, together with such witnesses’ addresses and telephone numbers and the topics and documents about which each witness may testify, are necessary and required “to avoid[] incidents of unfair surprise to the adverse party and increases the likelihood of a fair disposition of the parties’ claims and defenses.” *Carl Karcher Enterprises, Inc. v. Carl’s Bar & Delicatessen, Inc.*, 98 U.S.P.S. 2d 1370, 1372 n.4 (TTAB 2011); *see also Jules Jurgensen/Rhapsody, Inc. v. Peter Baumberger*, 91 U.S.P.Q. 2d 1443 (TTAB 2009) (granting motion to strike petitioner’s testimony deposition of witness based upon petitioner’s failure to identify witness in its initial disclosures or its pretrial disclosures, holding that undisclosed witness of this sort was precisely the “type of surprise witness that pretrial disclosure practice is intended to discourage”).

A party that fails to provide information in its initial and/or pretrial disclosures “may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, ‘unless the failure was substantially justified or is harmless.’” *Spier Wines (PTY) Ltd.*, 105 U.S.P.Q. 2d at 1242 (quoting Fed. R. Civ. P. 37(c)(1)). The adverse party may, when faced with such circumstances, file a motion to quash the deposition of a witness not named in pretrial disclosures in advance of the noticed deposition, or the adverse party may proceed with the deposition and cross-examine the witness under protest, reserving the right to object, and then move to strike the testimony from the record promptly after completion of the deposition. *See Carl Karcher Enterprises, Inc.*, 98 U.S.P.S. 2d at 1372 n.4. The Board has explained that “[a]s a practical matter . . . where a party believes it’s adversary’s pretrial disclosures are technically deficient in some manner, judicial economy is best achieved by bringing such issue up promptly by a motion before the deposition takes place.” *Id.*

II. Petitioner’s Failure to Disclose Ms. Martin was Neither Substantially Justified or Harmless.

In determining whether a failure to disclose a witness in initial disclosures, pretrial disclosures or any supplements thereto is substantially justified or harmless, the Board analyzes five factors: “1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the non-disclosing party’s explanation for its failure to disclose the evidence.” *Great Seats, Inc. v. Great Seats, Ltd.*, 100 U.S.P.Q. 2d 1323, 1327 (TTAB 2011) (internal citations omitted).

Applying the foregoing factors to this matter, Petitioner’s failure to disclose Ms. Martin as a witness in supplemental initial disclosures or in its Pretrial Disclosures was not substantially justified or harmless. With respect to the first and second factors, Petitioner’s failure to identify

Ms. Martin in its Initial Disclosures, any supplemental disclosures or its Pretrial Disclosures did indeed result in surprise to Registrant. *See Spier Wines (PTY) Ltd.*, 105 U.S.P.Q. 2d at 1244. This surprise “was prejudicial, not harmless, because [Registrant] was deprived of the opportunity to seek discovery” of Ms. Martin. *Id.*

Petitioner could have identified Ms. Martin as a witness as early as February of 2012 when Overstock.com served the Compilation in response to the Subpoena. Most certainly by August 7, 2012, Petitioner indisputably knew about Ms. Martin and the purported relevance of her supposed interaction with Overstock.com when Petitioner quoted Ms. Martin’s exchange with Overstock.com from the Compilation in its Motion for Summary Judgment and characterized it as “evidence of consumer confusion.” Because Petitioner did not identify Ms. Martin as a person with discoverable information in supplemental initial disclosures, Registrant “was unable to conduct appropriate discovery with respect” to Ms. Martin and “[c]learly, [Registrant’s] inability to conduct discovery in connection with [Ms. Martin] was caused by [Petitioner’s] failure to fulfill its written disclosure obligations as to [Ms. Martin], and is not the result of any inaction on [Registrant’s] part.” *Spier Wines (PTY) Ltd.*, 105 U.S.P.Q. 2d at 1243.

Petitioner’s contention that Registrant will have the opportunity to “cross-examine Ms. Martin during Ms. Martin’s testimony deposition” and “to call Ms. Martin as a witness during its own testimony period” is flawed given the differences between a discovery deposition and a testimony deposition, including but not limited to the permitted scope of cross-examination. *See* TBMP § 404.09. In addition, if Registrant were to take Ms. Martin’s testimony deposition without the benefit of taking a discovery deposition, such testimony deposition would become part of the record in Registrant’s case, regardless of the substance of that testimony. *See* TBMP § 404.09. Petitioner’s further assertion that Registrant cannot claim surprise by the disclosure of

Ms. Martin or the subject of her testimony because Registrant received a copy of the Compilation is erroneous. The surprise stems from Petitioner's sudden and untimely disclosure, 14 days before the close of its testimony period, that Petitioner wishes to rely upon the testimony of Ms. Martin, a previously undisclosed witness, not from the content of the Compilation.

Petitioner's argument that any prejudice to Registrant resulting from Petitioner's failure to disclose Ms. Martin in its Pretrial Disclosures is due to Registrant's decision not to depose Ms. Martin is flawed and incongruous. First, Petitioner's "obligation to serve initial, expert and pretrial disclosures are independent requirements of the [Trademark Rules]" and not ones "that can be ignored simply because some information about a testifying individual may be known to the adverse party or parties." *Jules Jurgensen/Rhapsody, Inc*, 91 U.S.P.Q.2d at 1445; *see also Spier Wines (PTY) Ltd.*, 105 U.S.P.Q. 2d at 1243. Second, Ms. Martin's testimony purportedly bears on the issue of likelihood of confusion. Petitioner, not Registrant, bears the burden of proving likelihood of confusion in this proceeding. It makes little practical sense to suggest that Registrant had an obligation to depose Ms. Martin in the absence of any designation by Petitioner of Ms. Martin as a person with discoverable information upon whom Petitioner might rely or as a trial testimony witness. In addition, the Compilation is 85 pages and includes numerous purported customer communications. Absent a disclosure by Petitioner that it was relying upon any particular individual identified in the Compilation as a witness, Registrant has no obligation or incentive to depose each of these purported customers.

As to the third factor, allowing the deposition of Ms. Martin at this juncture will undoubtedly disrupt the trial. Registrant is entitled to take a discovery deposition of Ms. Martin. If the Board permits Petitioner to amend its Pretrial Disclosures and take Ms. Martin's testimony deposition, Registrant requests that discovery be reopened for the limited purpose of allowing

Registrant² to depose Ms. Martin and conduct any follow-up discovery Registrant requires as a result of Ms. Martin's testimony and Petitioner's belated designation. This will undoubtedly disrupt the trial.

With respect to the fourth factor concerning the importance of the evidence, Petitioner has failed to include a copy of its proposed amended Pretrial Disclosures in its Motion, making it difficult to fully assess this factor. Based upon Petitioner's Motion for Summary Judgment it appears that Petitioner believes Ms. Martin's testimony is relevant to the issue of confusion. Even if Ms. Martin testifies that she was confused as a result of Registrant's BODIPEDIC & Design trademark, which is the subject of this proceeding, Ms. Martin would be the sole witness on this issue. A single instance of consumer confusion is not persuasive evidence of a likelihood of confusion. "[O]wnership of a trademark does not guarantee total absence of confusion in the marketplace." *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978) (noting 19 instances of "confusion" over period of four years insufficient to establish likelihood of confusion). As such, Ms. Martin's testimony, standing alone, is not sufficiently important to Petitioner's case. In addition, the alleged importance of Ms. Martin's testimony is but one of five factors to be considered and should not weigh heavily in Petitioner's favor, particularly because Petitioner has created this situation by its own conduct.

The fifth and final factor weighs in favor of Registrant. Petitioner has failed to come forward with a truthful and plausible explanation for its failure to identify Ms. Martin in supplemental initial disclosures or in its Pretrial Disclosures. Petitioner has plainly known Ms. Martin's identity since February 10, 2012 and had the full substance of Ms. Martin's purported

² Registrant respectfully submits that Petitioner should not be permitted to take any further discovery in the event that the Board grants Petitioner's Motion and affords Registrant the opportunity to depose Ms. Martin and conduct related discovery. If the Board resets the trial periods, Registrant further requests that Petitioner only be permitted

communication with Overstock.com as of that same date. Petitioner's Motion for Summary Judgment directly refutes Petitioner's explanation made in its Motion and establishes the falsehood of that explanation. A quick review of the deposition transcript of Overstock.com together with the Compilation and Petitioner's Motion for Summary Judgment lays bare Petitioner's attempt at an end-run around the Board's disclosure rules.

A balancing of these five factors establishes that Petitioner's failure to disclose Ms. Martin in its Pretrial Disclosure or in supplemental Initial Disclosures was not substantially justified or harmless. The surprise and resultant prejudice to Registrant is clear. As such, Petitioner's Motion should be denied in its entirety and the Cross-Motion should be granted.

CONCLUSION

In view of the foregoing, Petitioner's Motion should be denied and Registrant's Cross-Motion should be granted.

Dated: January 8, 2014

MCCARTER & ENGLISH, LLP
Attorneys for Registrant
Sleep Innovations, Inc.

By: Irene M. Hurtado
Scott. S. Christie
Irene M. Hurtado

to take Ms. Martin's deposition because Petitioner, as of January 17, 2014, will have had the benefit of a 60 day testimony period in this matter.